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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/481,153 01/12/00 MASTERS

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EXAMINER

026271 PM82/0717
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HOUSTON TX 77010-3095

YIP, W

ART UNIT

PAPER NUMBER

3635

DATE MAILED:

07/17/01

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/481,153

Applicant(s)
Masters et al.

Examiner
Winnie Yip

Art Unit
3635



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 19, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8, and 12-21 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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Part III DETAILED ACTION

This office action is in response to applicant's amendment filed on April 19, 2001.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 U.S.C. § 112

1. Claims 16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In these claims, it is confusing whether or not "the securing mechanism" or "the thread member " is also made of **fiberglass** since the securing mechanism or the threaded member is also an element of the apparatus which is formed of corrosion resistant material as previously recited.

Claim Rejections - 35 U.S.C. § 102

2. Claims 7-8, 14-16 and 18-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by document D of the information disclosure statement filed 07/07/2000 for the same reasons set forth the last office action mailed 09/07/ 2000.

The document D, the details of the "Stair Tread attachment detail in wave zone", discloses L-shaped connector (see detail 1 of section A) and plate fasteners (section A-B) each of which includes a threaded member extending between the top and the bottom plates and

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through openings of the top and bottom plates for clamping the plates together from a top position on the top surface of the grating sheet as claimed.

3. Claims 7, 8, 12, and 14 stand rejected under 35 U.S.C. 102(b) as being anticipated by document B of the information disclosure statement filed 07/07/2000 for the same reasons set forth the last office action mailed 09/07/2000.

4. Claims 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Document C of the information disclosure statement filed 07/07/2000.

The document C, the options I and II, discloses a plate fastener includes a threaded member mounted on a bottom plate and extending between the top and the bottom plates through an opening of the top plate, and clamping the plates together through a grating sheet by fastening the nut on a top surface of the top plate from a position on a top surface of the grating sheet as claimed.

5. Claims 7-8, 14, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Correll '147.

Correll an apparatus comprising a "G-clip" meet the limitation of the plate fastener as claimed which includes a threaded member (30) extending between a top plate (28) and a bottom plate (57) and through an opening (29) in the top plate (28) for engagement with a threaded nut

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(22) for clamping the plates together from a position on the top surface of the grating sheet (40) as claimed such that **the plate fastener can be installed from above the grating sheet and without any hole in the bottom plate (see abstract).** Wherein, the apparatus is capable to withstand the forces of waves in a wave-zone portion of an offshore platform area. (Notice, the environment of the platform area, such as a wave-zone portion, merely recites an intended use which is given very little patentable weight).

Claim Rejections - 35 U.S.C. § 103

6. Claims 17 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Document D for the same reason set forth the last office action mailed September 7, 2000.

7. Claim 13 is stand rejected under 35 U.S.C. 103(a) as being unpatentable over Document B, D, or Correll '147 for the same reason set forth the last office action mailed September 7, 2000.

Allowable Subject Matter

8. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims for the same reasons set forth the prior office action.

Response to Amendment

9. Applicant's arguments filed November 16, 1998 have been fully considered but they are not deemed to be persuasive.

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In response to applicant's argument that Document D, or Document B, or Correll (US Patent No. 5,118,147) teach the G-clips and J-clips being used for securing fiberglass grading on an offshore platform and being not capable to secure the grading sheet in an offshore platform environment that is subject to severe wave action, the recitations of "a grating sheet" and "the structural member in a wave zone area of an offshore platform" have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, since applicant only claims an apparatus for securing a grating sheet to a structural members, but not include the grating sheet and the structural members such as the offshore platform. Therefore, the environment of the offshore platform is not considered to be part of the claimed invention. The G-clips of Documents D or B or Correll's apparatus are considered capably used to secure a grating sheet to an offshore platform which could be severed in the wave action. Further, Correll '147, as well as the Document D, clearly define the G-clip and the J-clip "can be installed from above the grating" which read on the limitation as recited.

In response to applicant's argument that the Document D, the "Stair Tread" detail, fails to show certain features of applicant's invention such as a securing mechanism extending between

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the upper surface of the top plate and the opening of the bottom plate for clamping the top and bottom plate together through a grating sheet from a position on the top surface of the grating sheet", it is noted that the features upon which applicant relies (i.e., no need to secured underneath the support member) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In this application, applicant only recites the securing mechanism being secured form a position on a top surface of the grating sheet, but does not directly claim the securing mechanism can not be secured form the underneath of the grating sheet. The reference , the "Stair Tread" details, shows the securing mechanism having a threaded bolt extending form the top plate to the bottom plate through a grating sheet, one ordinary skill in the art can hold the nut in plate and then rotating the threaded head of the bolt above the top plate for clamping the top and bottom plates and the grating sheet together as claimed. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the rejections deemed proper.

ACTION IS FINAL

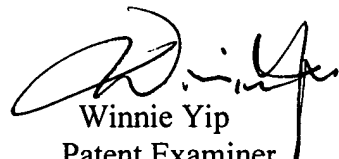
10. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Yip whose telephone number is (703) 308-2491. The examiner can normally be reached on Mondays through Friday from 9:30 AM to 6:00 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax phone number for this Group is (703)305-7687.


Winnie Yip
Patent Examiner
Group Art Unit 3635

July 13, 2001